



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/992,036

11/23/2001

Michael D. Dahlin

1039-0040

4450

34456

7590

05/12/2008

LARSON NEWMAN ABEL POLANSKY & WHITE, LLP  
5914 WEST COURTYARD DRIVE  
SUITE 200  
AUSTIN, TX 78730

EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

05/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/992,036	<b>Applicant(s)</b> DAHLIN ET AL.	
	<b>Examiner</b> Natalie A. Pass	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-11, 16-20, 25-31, 39-44 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11, 16-20, 25-31, 39-44 and 51-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 March 2008 has been entered.
2. This communication is in response to the Request for Continued Examination and amendment filed on 10 March 2008. Claims 1-8, 12-15, 21-24, 32-38, and 45-50 have been cancelled. Claims 9, 18, and 39 have been amended. Claims 52-53 have been newly added. Claims 9-11, 16-20, 25-31, 39-44 and 51-53 remain pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Newly amended claim 39 and newly added claim 53 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 39 and 53 recite limitations that are new matter, and are therefore rejected.

The added material which is not supported by the original disclosure is as follows:

- "the indication resulting from the user selecting the tri-state control twice" in claim 39 at lines 4-5, and in claim 53 at lines 15-16.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 23 November 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 23 November 2001.

Art Unit: 3626

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 39 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Newly amended claim 39 recites the limitation "the tri-state control" in line 5.

There is insufficient antecedent basis for this limitation in the claim.

(B) Newly added claim 52 recites the "the method of claim 18" in the preamble, however claim 18 recites a device. Correction is required. For the purpose of applying art, Examiner assumes the preamble of claim 52 to read "the device of claim 18."

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**NOTE:** The following rejections assume that the subject matter added in the 10 March 2008 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and

Art Unit: 3626

rejections made in sections 3-5 above in the next communication sent in response to the present Office Action.

9. Claims 9-11, 16-20, 25-31, 39-44, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent Application Publication No. 2001/0041992 for substantially the same reasons given in the previous Office Action (paper number 20070831) (it should be noted that the Examiner is relying on the priority date from the Lewis parent application 09/523,569; based on review of the parent application it is believed that the portions of the child application cited below are fully supported by the parent application), and further in view of Yoder, J. et al., The MEDIGATE Graphical User Interface for Entry of Physical Findings: Design Principles and Implementation. Journal of Medical Systems. Vol. 22, No. 5 / October, 1998, pages 325-337. URL: <<http://www.springerlink.com/content/g8504238744271h2/fulltext.pdf>>, hereinafter known as Medigate. Further reasons appear hereinbelow.

(A) Claim 9 has been modified to include the recitation of "at least partially" in line 11.

As per amended claim 9, Lewis teaches a method for documenting medical findings of a physical examination, the method comprising:

displaying a first interface including a first graphical representation of anatomical features (see paragraph 0059);

accepting from a user a first selection of an anatomical feature based on the first graphical representation of anatomical features (see paragraph 0059);

displaying a second interface including a second graphical representation of anatomical features and a first set of controls relating to a first plurality of medical conditions in response to accepting the first selection (see paragraph 0061), the second graphical representation of anatomical features and the first set of controls displayed simultaneously without obstructing each other (see paragraph 0110 and Figure 4H, note that the controls relating to medical conditions such as ‘SHOULDER SPRAIN’, ‘ROTATOR CUFF TEAR’, etc. are simultaneously displayed but do not obstruct the graphical representation of anatomical features);

accepting from the user a second selection from the second graphical representation of anatomical features (see paragraph 0065); and displaying a third interface including a second set of controls relating to a second plurality of medical conditions (see paragraph 0065).

Although Lewis teaches the second graphical representation of anatomical features and the first set of controls displayed simultaneously without obstructing each other (as discussed above), Lewis fails to explicitly disclose without at least partially obstructing each other.

However, the above features are well-known in the art, as evidenced by Medigate.

In particular, Medigate teaches a method including the second graphical representation of anatomical features and the first set of controls displayed simultaneously without at least partially obstructing each other (Medigate; Figure 2, page 332).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lewis to include these limitations, as taught by Medigate, with the motivations of providing a means “to elucidate findings from the physical exam and to investigate and implement an interface for the collection of these findings” with a “system ...

[that is] ... rapid and easy to use, reduce[s] error, facilitate[s] interactive processing and immediate user feedback, and capture[s] quantitative and qualitative clinical data” (Medigate; page 326, paragraph 1).

(B) As per claims 10-11, Lewis and Medigate teach the method of claim 9 as described above, and further teach

the first graphical representation of anatomical features includes a graphical representation of a plurality of body locations (Lewis; paragraph 0059), (Medigate; Figure 1, page 330);

the first selection comprises a response indicative of one of the plurality of body locations (Lewis; paragraph 0059), (Medigate; Figure 2, page 332).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

(C) As per claims 16-17, Lewis and Medigate teach the method of claim 9 as described above, and further teach

the step of displaying the first interface and the step of displaying the second interface take place in different views (Lewis; Figures 4A and 4B), (Medigate; Figure 1, page 330, Figure 2, page 332);

displaying the second interfaced comprises displaying the second graphical representation in response to the first selection by the user, the first selection indicating a portion of anatomical features associated with the first graphical representation to be displayed, the



Art Unit: 3626

second graphical representation including the portion of the anatomical features with greater detail (Lewis; paragraph 0061), (Medigate; Figure 1, page 330, Figure 2, page 332).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

(D) Claims 18-20 and 25-26 recite substantially similar apparatus limitations to method claims 9-11 and 16-17 and, as such, are rejected for similar reasons as given above.

(E) As per claim 27, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second interface includes a drill down button (see paragraph 0007).

(F) As per claim 28, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second interface includes a change system button (see paragraph 0064).

(G) As per claim 29, Lewis and Medigate teach the method of claim 28 as described above. Lewis further teaches displaying a list of systems associated with the first selection in response to a user selection of the change system button (see paragraph 0064).

(H) As per claim 30, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second interface includes a procedure button (see paragraph 0063).

(I) As per claim 31, Lewis and Medigate teach the method of claim 30 as described above. Lewis further teaches displaying a list of procedures associated with the first selection in response to a user selection of the procedure button (see paragraph 0111).

(J) As per claim 39, Lewis and Medigate teach the method of claim 9 as described above further comprising

accepting from the user an indication of “Normal” (reads on “not present”), the indication resulting from the user selecting the tri-state control twice (Medigate; page 330, paragraph 2, paragraph bridging pages 331-332); and

storing data associating the indication with the first selection (Medigate; paragraph bridging pages 331-332).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

(K) As per claim 40, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the first set of controls includes an annotation control (see Figures 4A-4J).

(L) As per claim 41 Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second plurality of medical conditions represents a greater level of detail than the first plurality of medical conditions (see paragraph 0065).

(M) As per claim 42 Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second and third interface include a list of recent findings (see Figures 4A-4J).

(N) As per claim 43, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches displaying the first, second, and third interface are performed on a palm-top computer configured for use by a physician (Lewis; see paragraph 0033), (Medigate; paragraph bridging pages 333-334).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

(O) As per claim 44, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches accepting from the user a third selection, the third selection including changing one control of the first set of controls (see paragraph 0048); and combining the first selection and the third selection to derive at least one medical finding (see paragraph 0048).

(P) As per claim 51, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second graphical representation of anatomical features and the first set of controls are simultaneously active (see paragraph 0110 and Figure 4H).

(Q) Newly added claim 52 recites substantially similar apparatus limitations to method claim 51 and, as such, is rejected for similar reasons as given above.

(R) As per newly added claim 53, Lewis and Medigate teach a method for documenting medical findings of a physical examination, the method comprising:

displaying a first interface including a first graphical representation of anatomical features (Lewis; paragraph 0059);

accepting from a user a first selection of an anatomical feature based on the first graphical representation of anatomical features (Lewis; paragraph 0059);

displaying a second interface including a second graphical representation of anatomical features and a first set of controls relating to a first plurality of medical conditions in response to accepting the first selection (Lewis; paragraph 0061), the second graphical representation of anatomical features and the first set of controls displayed simultaneously without obstructing each other (Lewis; paragraph 0110 and Figure 4H), (Medigate; Figure 2, page 332), wherein the second graphical representation of anatomical features and the first set of controls are simultaneously active (Lewis; paragraph 0110 and Figure 4H), wherein the first set of controls includes a tri-state control configured to indicate present, not present, or not entered (Medigate; page 330, paragraph 2);

accepting from the user an indication of “Normal” (reads on “not present”), the indication resulting from the user selecting the tri-state control twice (Medigate; page 330, paragraph 2, paragraph bridging pages 331-332);

combining the first selection and the indication to derive at least one medical finding (Lewis Figures 4A-4J, paragraph 0048);

accepting from the user a second selection from the second graphical representation of anatomical features (Lewis; paragraph 0065); and

displaying a third interface including a second set of controls relating to a second plurality of medical conditions (Lewis; paragraph 0065).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

### ***Response to Arguments***

10. Applicant's arguments filed 10 March 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10 March 2008.

(A) As per Applicant's arguments in paragraph 3 on page 7 relating to discrepancies between the applied Lewis reference and the parent application of the Lewis reference (09/523,569), Examiner notes that although the diagrams are not labeled identically to the applied Pre-Grant Publication, and although the diagrams are not identical, nevertheless Examiner interprets the subject matter, to teach Applicants limitations. For example, numerous figures, such as Figures 4A-4E of the parent application of Lewis show examples of a graphical interface which simultaneously displays a graphical representation of anatomical features (401 , 410) and a set of controls (404, 412) relating to the plurality of medical conditions. In addition, descriptive text further elucidates the Lewis parent application (for example, see the Lewis parent application; page 4, lines 11-21, page 7, lines 24-30, page 15, lines 11-32, paragraph bridging pages 15-16, paragraph bridging pages 23-24, paragraph bridging pages 25-26, page 29,

Art Unit: 3626

lines 3-21, and Figure 6 flow chart). Throughout the text, the parent application demonstrates interactively drilling down through anatomical features displayed on a user interface. Therefore, the Examiner respectfully disagrees with Applicants' interpretation of the teachings of the Lewis parent application, and interprets the Lewis reference to show teachings where applied. In addition, Examiner notes that it is the teachings of the combined, applied art, Lewis and Medigate, that must now be considered when evaluating the 35 USC § 103 rejections.

(B) The remainder of Applicant's arguments regarding pending claims 9-11, 16-20, 25-31, 39-44 and 51-53 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. A. P./

Examiner, Art Unit 3626

April 14, 2008

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626